

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

08/819,669

Applicant(s)

BOON ET AL.

Examiner

Phillip Gambel

Art Unit

1644

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: 192-195.
 Claim(s) objected to: _____.
 Claim(s) rejected: 183-191.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

/Phillip Gambel/
Primary Examiner, Art Unit 1644

Continuation of 11, does NOT place the application in condition for allowance because: of the reasons of record.

Applicant's submission of a duplicate amendment, faxed 08/18/2009, is acknowledged.

Claims 183-191 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,843,448 (see 892, mailed 03/28/2001) for the reasons of record.

The Terminal Disclaimer over U.S. Patent No. 5,843,448, filed 07/13/2009, has been DISapproved for the following reasons.

While it is acknowledged that the Terminal Disclaimer, filed 07/13/2009, has incorporated the "not separately enforced" language of 37 CFR 1.321(d)(3) with respect to reliance upon a joint research agreement, this Terminal Disclaimer still indicates that the instant application is commonly owned with U.S. Patent No. 5,843,448.

This stands in contrast to the record of the instant application.

In the Petition To Withdrawn Terminal Disclaimer, filed 05/02/2008, applicant noted the following facts.

"On December 6, 2006, the Examiner rejected the claims of this application on double patenting grounds, in view of U.S. Patent No. 5,843,448. The '448 patent issued with the incorrect assignees on its face. The record of its prosecution indicates, however, that the patent was co-owned: As such an obviousness-type double patenting rejection, and a terminal disclaimer are not appropriate. Please see the assignment documents from the parent application, i.e., U.S. Patent No. 5,541,104, indicating that there are two assignees, one of whom (Cornell Research Foundation, Inc), is NOT an assignee of the current application. In short, co-ownership does not exist."

In view of the foregoing, it is requested that the Terminal Disclaimer filed over U.S. Patent No. 5,843,448, be WITHDRAWN.

It is noted that the Petition to Withdraw the Terminal Disclaimer, filed 12/12/2006, was granted and mailed on 07/21/2008.

As noted previously, while a terminal disclaimer is not proper between this application and U.S. Patent No. 5,843,448, an obviousness-type double patenting rejection is still deemed proper. An obvious-type double patenting rejection is proper when there is at least one common inventor, even if there is no common ownership. For example, see Chart II-B in MPEP 804 (follow the center path). Establishing a lack of common ownership removes the option of overcoming the obviousness-type double patenting rejection via a terminal disclaimer, but it does not overcome the obviousness-type double patenting rejection.

As noted previously, given that the reference (U.S. Patent) and the pending application have the SAME effective filing / priority date; the reference does not fall within the scope of 35 USC 103(c)(1), since the U.S. Patent is NOT available under 102(e).

Therefore, the nonstatutory double patenting rejection between the instant application and U.S. Patent No. 5,843,448 cannot be overcome by a terminal disclaimer citing the provision of 37 CFR 1.321(d)(3). That is another reasons the terminal disclaimer has been disapproved.

The terminal disclaimer filed on 07/13/2009, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 5,843,448 has been reviewed and has not been accepted.

With respect to ODP with U.S. Patent No. 7,495,074; it is noted that applicant still has not addressed the following issue concerning double patenting with commonly assigned U.S. Patent No. 7,495,074.

Applicant should address the following.

Claims 183-191 and newly added 192-195 are directed to an invention not patentably distinct from claims 1-8 of commonly assigned U.S. Patent No. 7,495,074 for the reasons of record.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No., discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Applicant should clearly indicate the ownership of the instant application and that of U.S. Patent No. 7,395,074. While applicant asserts that there is common ownership, it remains unclear whether the instant application and the patent are totally commonly owned, rather than having an owner in common;

given the record of the instant application where USPTO records are inconsistent with applicant's assertions about ownership or the inconsistency between applicant's statement in the Terminal Disclaimer filed 07/13/2009 about common ownership and applicant's previous Petition to Withdraw the Terminal Disclaimer, filed 12/12/2006.

With respect to applicant's comments about the ODP rejection itself, the claims of U.S. Patent No. 7,495,074 drawn to MAGE-4 tumor rejection antigens anticipated the instant claims.